



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,263	07/01/2008	Alfred Werner Widmer	990784.00004	6586

26735 7590 01/19/2010
QUARLES & BRADY LLP
33 E. MAIN ST, SUITE 900
P.O BOX 2113
MADISON, WI 53701-2113

EXAMINER

ROBINSON, BINTA M

ART UNIT	PAPER NUMBER
----------	--------------

1625

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

01/19/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pat-dept@quarles.com

Office Action Summary	Application No. 10/579,263	Applicant(s) WIDMER ET AL.	
	Examiner BINTA M. ROBINSON	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Response to Restriction filed 9/14/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/12/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/25/07;11/01/07</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Detailed Action

2. The examiner notes the applicant's election of Group I, drawn to claims 1-8 and the election of a single disclosed species 1,12-bis (triisopentylammonium)dodecane with traverse. The applicants traverse the restriction/election alleging that it would not be a burden on the USPTO to search both groups because allegedly both groups cover the same art, and the scope of the searches would overlap significantly. However, this is not so in the examiner's opinion. Group I claims are drawn to compound claims and can be searched in various classes ranging from 544, 546, 548, and 549 and various subclasses within these classes, as well as in various non-heterocyclic classes - whereas, a search of Group II, would involve various subclass searches in 514 and not in 544, 546, and 548, and 549. It would be quite a burden on the USPTO to search all of these non-coextensive searches because they do not overlap significantly.

Additionally, a separate text search would have to be done for each of the diseases and conditions claimed in Group II, that would not be required in Group I. The examiner showed that the lack of unity exists because the Kocharyen compound does not make a contribution over the art and therefore, Groups I and II do not form a single general inventive concept, which justifies the restriction. The applicant also traverses the election of species requirement, however, the species do not form a common core because A can be an alkylene, and alkenylene, and alkynylene, a phenyl, a C5-7 cycloalkyl, and a -C(O)- all of which can be optionally substituted. Therefore, the restriction/election is made FINAL. Claims 9-17 are withdrawn from consideration as being drawn to non-elected subject matter.

Art Unit: 1625

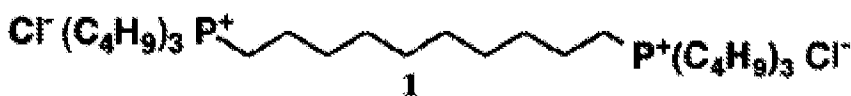
3. Claim 1 is objected to because of the following informalities: There is no period at the end of claim 1. Appropriate correction is required.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 5, 6, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Salvino et. al. Salvino et. al., discloses the instant compound,

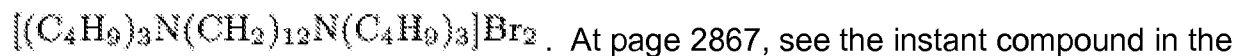


. At page 357, see the

instant compound.

6. Claims 1, 2, 4-5, 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Tamaki et. al.

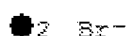
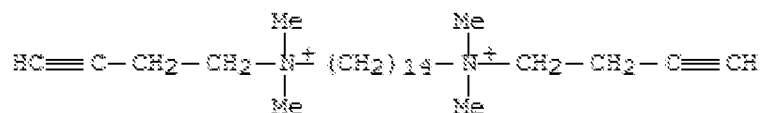
7. Tamaki et. al. discloses the instant compound,



. At page 2867, see the instant compound in the Synopsis.

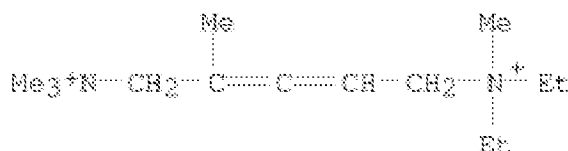
Art Unit: 1625

Claim(s) 1, 2, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Vial et. al., Hcaplus 1998:98316 abstract. Hcaplus 1998:98316 abstract discloses



the instant compound,

8. Claims 1-2, 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kocharyan et. al., Hcaplus 1984: 510322 Abstract. Kocharyan et. al., Hcaplus 1984: 510322 Abstract discloses the instant compound,



9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1625

A. In claim 1, line 26, page 4, and all other occurrences throughout the claims, the phrase "and salts thereof" renders the claims indefinite because it is not clear if a single compound species is being claimed or a composition.

The elected species is allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0670.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703305-3592, and (703305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

/Janet L. Andres/

Supervisory Patent Examiner, Art Unit 1625